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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/852,484 05/10/01 NEVILL

D PH/5-30706A

EXAMINER

HM12/1002

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ART UNIT

PAPER NUMBER

1616

DATE MAILED:

10/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/852,484

Applicant(s)
Nevill et al

Examiner
Mark Clardy

Art Unit
1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 20, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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Claims 1-20 are pending in this application which has been filed as a continuation of PCT/EP99/08559, filed November 8, 1999.

Applicants' claims are drawn to a synergistic composition for the selective control of broad-leaf weeds and grasses in crops which are resistant to protoporphyrinogen oxidase (PPO) inhibitors comprising (claim 1):

- a) a PPO inhibiting herbicide¹
- b) at least one additional pesticide (herbicide², fungicide, insecticide)
- c) optionally, a safener³.

Pages 10-326 are merely a generated list of permutations of herbicide combinations. No data is evident in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

¹Claims 3-6: diphenyl ethers: acifluorphen, aclonifen, bifenox, chlornitrophen, ethoxyfen, fluroglycofen, formesafen, lactofen, oxyflurfen;
imides: azafenidin, carfentrazon, cinidon, flumiclorac, flumioxazin, fluthiacet, oxadiargyl, oxadiazon, pentoxazone, slufentrazone, flumipropyn, flupropacil, benzfendizone, formula A (claim 5);
phenylpyrazoles: nipyraclufen, pyraflufen;
fluazolate, thidiazimin.

²Claims 8, 9, 11-20 list virtually every known herbicidal agent.

³Claim 10: benzoxazin (benoxacor), MON 4660, flurazole, dichlormid, furilazole.

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A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 10 recites the broad recitation "benzoxazin type", and the claim also recites "benoxacor" which is the narrower statement of the range/limitation.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 6,127,318) further in view of Volrath et al (US 6,084,155) and Devine et al⁴.

⁴Devine et al. *Physiology of Herbicide Action*. Section 8.4 "Inhibitors of protoporphyrinogen-oxidase". PTR Prentice Hall: NJ. P. 152-163. 1993.

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Sato et al teach the combination of glyphosate and a PPO inhibiting herbicide such as the triazolinones (col 2, lines 11-12), two of which are carfentrazone and sulfentrazone (col 3, lines 56-67).

Volrath et al teach that applicants' PPO inhibiting herbicides were known (col 37-44).

Devine et al teach that there were several known antagonists (safeners) of the PPO inhibiting nitrodiphenylether herbicides (Table 8.4, p. 157).

One of ordinary skill in the art would be motivated to combine these references because Sato teaches the utility of PPO inhibiting herbicides which are further defined and characterized in the secondary references.

Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined PPO inhibiting herbicides with additional pesticidal agents, and safeners, because Sato teaches that glyphosate is useful in such a combination. Further, it is conventional in the art to make use of safeners for herbicides, several of which are disclosed in Devine et al.

No unobvious or unexpected results are noted; no claim is allowed.

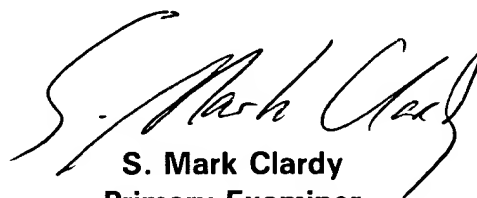
This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103c and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a)

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.



S. Mark Clardy
Primary Examiner
AU 1616

September 30, 2001